

REMARKS

In the Office Action, the Examiner rejected claims 11-15, 17-20, 26, 30-35, 38 and 39, allowed claims 21-25 and 40-44, and objected to claims 16, 27-29, 36 and 37 for containing allowable subject matter but depending from a rejected base claim. Of the rejected claims, claims 11, 26 and 33 are independent. By the present Response, claims 11, 13-15, 26, 27, 33 and 35-37 are amended, claim 17 has been cancelled and new claims 45-55 are added. With respect to the new and amended claims, Applicants respectfully assert that no new matter has been added. Upon entry of the amendments, claims 11-16 and 18-55 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 11-13, 15, 17, 26 and 30 under 35 U.S.C. § 102(b) as anticipated by McDonough (U.S. Patent No. 5,920,290; hereinafter the “McDonough reference” or “McDonough”).

Legal Precedent

A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). As amended, claims 11 and 26 are not anticipated by McDonough because the reference fails to disclose each and every element of the claims.

Independent Claims 11 and 26 and Claims Depending Therefrom

As amended, claim 11 recites a “multi-layer surface . . . comprising . . . a conductive antenna printed on the resin impregnated cellulosic layer” As amended, claim 26 recites “a first laminate structure attached to a first surface of the shelf substrate, wherein the first laminate structure comprises a resin impregnated cellulosic layer, a conductive antenna printed on the resin impregnated cellulosic layer”

In contrast, McDonough discloses resonant tag labels where a plate may be formed by application of conductive inks onto the base for the label structure. McDonough, col. 4, lines 22-28. In addition, McDonough discloses a structure where “a spiral antenna pattern 21, is applied to the dielectric coating” where the “dielectric material can consist of any number of conventionally available polymeric materials, such as acrylics, polyester, polyurethanes, silicones, etc.” McDonough, Col. 4, lines 60-63 and 65-66.

Applicants respectfully submit that McDonough fails to teach at least “a conductive antenna printed on the *resin impregnated cellulosic layer*” While the reference discloses the use of conductive inks to form plates, they are clearly not utilized in the formation of an antenna on a resin impregnated cellulosic layer. McDonough also discloses the application of an antenna pattern to a *polymeric base layer* of the tag label. Applicants note that McDonough is silent as to how the antenna is formed prior to application to the label base.

For these reasons, Applicants respectfully submit that the McDonough reference fails to disclose a structure having a conductive *antenna* printed on a *resin impregnated cellulosic layer*, as recited in independent claims 11 and 26. Because the McDonough reference fails to disclose such elements, the cited reference fails to anticipate independent claims 11 and 26. For at least these reasons, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102 and allowance of claims 11 and 26.

Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 14, 33-35, 38 and 39 under 35 U.S.C. § 103(a) as unpatentable over McDonough in view of Kayanakis (U.S. 2005/0066513; hereinafter the “Kayanakis reference” or “Kayanakis”). Of the rejected claims, claim 33 is independent.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Independent Claim 33 and Claims Depending Therefrom

With regard to independent claim 33, the cited combination of the McDonough and Kayanakis references does not disclose at least “[a] method for making a multi-layer structure, comprising . . . disposing a fluid on a resin impregnated cellulosic layer to form a conductive antenna,” as recited by amended claim 33. As stated above with respect to the other independent claims, McDonough does not provide for an antenna formed on a resin impregnated cellulosic layer, but instead discloses the application of an antenna to a polymeric base layer of the tag label. McDonough, col. 4, lines 60-63 and 65-66.

Furthermore, the Examiner did not assert that the Kayanakis reference discloses an antenna formed on a resin impregnated cellulosic layer. Indeed, the Kayanakis reference does not disclose such a feature, but instead is directed to “an antenna . . . on a *plastic* support . . . or on an *epoxy glass* support . . .” Kayanakis, paragraph 43 (emphasis added). Claim 33, as amended, clearly recites elements, including an antenna formed on a resin impregnated cellulosic layer, that are not provided by the McDonough or Kayanakis references, either alone or in concert.

It follows that because the cited references do not disclose each and every element of the claim, they cannot support a *prima facie* case of obviousness. Moreover, the Examiner has not provided any evidence of reasonable motivation or suggestion to combine the McDonough and Kayanakis references. For at least these reasons, Applicants respectfully submit that the subject matter of independent claim 33, as well as the claims dependent thereon, is not obvious in light of the cited art. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejections and allowance of claims 14, 33-35, 38 and 39.

New Claims

Support for new claims 45-55 can be found in the specification at least in the paragraphs beginning on page 7, line 17 and beginning on page 8, line 30 of the Application.

Conclusion

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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